

Application No.: 10/623,773
Amendment dated: December 9, 2004
Reply to Office Action of: September 9, 2004

REMARKS

Claims 1 and 9 have been amended, non-elected claims 11-13 canceled, and new claim 14 added to improve the clarity of the claimed subject matter and to bring the claims into conformity with U.S. practice and format, and to place the application fully in condition for allowance.

Applicant has not yet received an indication from the Examiner as to the acceptability of the originally filed drawings and requests such indication in the next Official Action, in the absence of which it is assumed that the original drawings are acceptable.

Claims 1-10 and 14 remain pending upon entry of the amendments to the claims above.

Allowable Subject Matter

Applicant thanks the Examiner for indicating that claim 4 would be allowable if rewritten in independent form. Accordingly, allowable claim 4 has been rewritten as new claim 14. New claim 14 is now believed to be in condition for allowance.

Claim Rejections under 35 U.S.C. § 102

Claims 1-3 and 6-10 are rejected under 35 USC 102 as being anticipated by U.S. 4,983,242 (Reed). Claims 1 and 5 are rejected under 35 USC 102 as being anticipated by U.S. 5,409,215 (You). Applicant most respectfully traverses this rejection. Further, independent claim 1 has been amended to more clearly claim the inventive subject matter.

Applicant respectfully wishes to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim

is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

Independent 1 has been amended to positively recite that the elastic member (20) is wrapped around a portion of the frame (12), and the cover layer (24) is wrapped around the portion of the frame (12) and the elastic member (20). Independent claim 1 further recites that the vibration wave transmission velocities of the frame (12), the elastic member (20) and the cover layer (24) are different from one another, which indicates that they are different materials. In contrast, in the reference to Reed, as illustrated in Figure 2, the dampening sleeve 26 which has been equated to the claimed elastic member, is sandwiched between inner and outer tubular frame members 12, 24, wherein both the inner and outer tubular frame members are of the same material. Therefore, it is respectfully believed that the vibration wave transmission velocities of the inner tubular frame member 22, the outer tubular frame member 12 and the dampening sleeve 26 of Reed cannot be different from one another, as claimed. In view of the amendments to independent claim 1 and the remarks above, withdrawal of this rejection is respectfully requested.

With regard to the reference to You, this reference discloses a tennis racket disclosing two shaft portions 62, a shock-absorbing ribbon 66 mounted on an external side of each of the two shaft portions 62, a bridging layer 70 and a surface treating layer 64, both covered on each of the shaft portions 62. The surface treating layer 64 serves to prevent the shock-absorbing ribbons 66 from becoming detached. The bridging layer 70 serves to enhance the binding power between the surface treating layer 64 and each shaft portion 62.

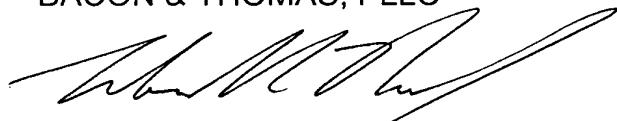
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The Examiner is referred to Figure 8 of You which illustrates a frame 62 covered by an interlayer 70/bridging layer, which is then covered over by the cover layer/surface treating layer 64. The bridging layer 70 of Reed is made of a fiber-reinforced plastic material (column 3, lines 24-25), which strongly indicates that the bridging layer 70 of Reed cannot be equated to being an elastic layer.

In view of the amendments to independent claim 1 and the remarks above, withdrawal of this rejection is respectfully requested.

In summary, it is respectfully submitted that none of the prior art individually or collectively shows the invention as claimed. Accordingly, withdrawal of the rejection of the claims appears to be warranted and the same is respectfully requested. In the event there are any outstanding matters remaining in the present application which can be resolved by a telephone call or facsimile communication to Applicant's Attorney, the Examiner is invited to contact the undersigned by telephone or facsimile at the numbers provided below.

Respectfully submitted,
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